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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GAUTAM GHOSE, CHANDRA PRASAD, RICHARD MEYER,
and RUSH MANBERT

Appeal 2009-005289
Application 10/695,889
Technology Center 2100

Before: JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-4, 6-16, 18-21, and 23-36. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to failure analysis method and system for storage area networks. (Title). Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for configuring a storage virtualization controller to manage errors in a storage area network, comprising:
 - initializing a primary failure analysis module for processing error events and error actions and an alternate failure analysis module configured as a backup to the primary failure analysis module to facilitate high-availability and redundancy;
 - identifying one or more predetermined error actions and one or more error events associated with the storage area network;
 - specifying, according to one or more rules, an error pattern based upon a combination of one or more error events in the storage area network; and
 - associating an error action to perform according to the one or more rules and in response to receiving the combination of one or more error events of the error pattern.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lewis	US 5,666,481	Sep. 9, 1997
Feridun	US 6,336,139	Jan. 1, 2002
D'Souza	US 6,446,218	Sep. 3, 2002
Harper	US 6,629,266	Sep. 30, 2003
Reuter	US 2002/0019922 A1	Feb. 14, 2002

REJECTIONS

Claims 1-4, 6-11, 18-21, 23-26, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, and Harper. (Ans. 3).

Claims 12-16, 27-32, 34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, Feridun, and D'Souza. (Ans. 7).

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, Harper, "threshold" defined by IEEE, and "graphical user interface", by Microsoft Computer Dictionary. (Ans. 15).

ISSUES

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, and Harper?

Did the Examiner err in rejecting claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, Feridun, and D'Souza?

Did the Examiner err in rejecting claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Reuter, Harper, "threshold" defined by IEEE, and "graphical user interface", by Microsoft Computer Dictionary?

PRINCIPLES OF LAW

Obviousness under §103

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be

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"more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citations omitted). "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

Just as "[i]t is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art," *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991), "it is not the function of this Board to examine claims in greater detail than argued by an

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appellant, looking for nonobvious distinctions over the prior art." *Ex parte Post*, No. 2005-2042, 2006 WL 1665399 at *4 (BPAI Jan.1, 2006).

ANALYSIS

At the outset we note that Appellants have not filed a Reply Brief to respond to the Examiner's position set forth within the Examiner's Answer.

Appellants argue that there is no reason to combine the teachings of Lewis with Reuter as they deal with non-analogous art. (App. Br. 11). We disagree with Appellants' narrow view of analogous arts. (App. Br. 11-15). We find the Examiner's discussion at pages 20-22 of the Examiner's Answer to further buttress the Examiner's initial presentation in the statement of rejection. We find Appellants' contentions do not show any error in the Examiner's combination of teachings.

Appellants argue that all the limitations are not taught or suggested by the cited art. (App. Br. 15). Appellants argue that contrary to the Examiner's assertion, Lewis alone or in combination with the cited does not teach each and every feature of the invention as claimed. Appellants contend that the Examiner's contention that "a functioning process must be initialized at some point" (App. Br. 16; citing the Office Action dated May 10, 2007) is "conclusory" and mere "supposition." (App. Br. 16). We disagree with Appellants' contentions and find that Appellants' claimed invention does not set forth any limitations on the step of "initializing..." with respect to the number of times the "initializing" step is performed or whether it is an iterative process. Therefore, it is sufficient that a single "initializing" step would be sufficient to be taught or suggested. Therefore, the Examiner's line of reasoning is correct and well based. We agree with

the Examiner that "common sense" dictates that most systems need to be initialized at the beginning of operation to operate properly. Therefore, Appellants' argument does not show error in the Examiner's presentation of the showing of obviousness of independent claim 1.

Appellants argue generally that the teachings of Lewis do not identify error events as recited in independent claim 1, but instead identify cases using "case-based reasoning" (CBR) and the Examiner's reliance thereon teaches away from specifying error patterns based upon one or more rules. (App. Br. 17-18). We disagree with Appellants' contentions and find the Examiner's discussion regarding claim interpretation and "rules" at pages 18-20 of the Examiner's Answer to be persuasive and adopt the Examiner's claim interpretation. We further note that only a single rule is required by the language of independent claim 1.

Appellants further contend that Lewis teaches away from aspects of the claimed invention and that Lewis details the operation of rule-based reasoning (RBR) systems and then proceeds to point out all its failures (App. Br. 19-21). We disagree with Appellants and find that while Lewis does discuss some of the shortcomings of rule-based reasoning systems, the claimed invention does not recite a rule-based reasoning system and only recites "one or more rules." We disagree with Appellants' conclusion and find that the two identified problems discussed by Lewis and the improved flexibility of the case-based reasoning does not rise to the level of a "teaching away" as Appellants contend. Therefore, we do not find Appellants' argument persuasive of error in the Examiner's showing of obviousness of independent claim 1. Appellants group claims 18 and 33, and dependent claims 2-4, 6-11, 19-21, and 23-26 with independent claim 1.

With respect to claims 12, 27, 34, and 36, Appellants set forth similar arguments as set forth with independent claim 1 further addressing the teachings of Feridun and D'Souza regarding the combination and that all the elements are not taught. (App. Br. 21-26). Similarly, as discussed above with respect to independent claim 1, we disagree with Appellants' contentions.

Appellants set forth similar arguments concerning Lewis teaching away which we found unpersuasive with respect to independent claim 1. (App. Br. 26-28). We similarly find those arguments unpersuasive with respect to independent claim 12. Therefore, we do not find Appellants' argument persuasive of error in the Examiner's showing of obviousness of independent claim 12. Appellants group claims 27, 34, and 36, and dependent claims 13-16 and 28-32 with independent claims 12 and 27.

With respect to independent claim 35, Appellants set forth similar arguments as addressed above (App. Br. 28-30) which we do not find persuasive of error in the Examiner's showing of obviousness.

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CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1-4, 6-16, 18-21, and 22-36 under 35 U.S.C. § 103.

DECISION

For the above reasons, the Examiner's rejection of claims 1-4, 6-16, 18-21, and 22-36 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

tkl

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